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Andrew T. Wilson

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DONELS, JEFFREY

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANDREW T. WILSON

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Appeal 2009-003616  
Application 10/684,167  
Technology Center 2800

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Before ROBERT E. NAPPI, JOHN C. MARTIN, and  
JOSEPH F. RUGGIERO, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

NEW DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellant has filed a “Request for Rehearing Under 37 C.F.R. 41.52” (hereinafter “Request”) of our “Decision on Appeal” (hereinafter “Decision”), mailed September 22, 2009.<sup>2</sup>

In affirming the rejection of independent claims 11 and 27 for obviousness over Ito in view of Sitrick, we (1) concluded that claim 11 does not require that *each* of the recited “at least two such apparatus” include the recited “audio score mixing mechanism” (Decision 12) and (2) found that Ito discloses a system including plural musical apparatus *each* containing an audio score mixing mechanism, as required by claim 27 (*id.* at 11-14). Appellant (Req. Reh’g 3) has requested a remand because the above reasons differ from those given by the Examiner. This “New Decision on Appeal” incorporates the contents of the initial “Decision” in its entirety and also includes a discussion of the arguments in the Request as well as an explanation of why we agree with the Examiner’s stated rationale for the rejection. Pursuant to 37 C.F.R. § 41.50(b), we are hereby designating the above-identified new reasons for affirming the rejection of claims 11 and 27 as constituting a new ground of rejection of those claims, thereby giving Appellant a right to reopen prosecution before the Examiner (*see infra*).

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<sup>2</sup> A “Decision on Petition” mailed April 21, 2010, granted a petition under 37 C.F.R. § 1.181(a) to withdraw the Examiner’s “Notice of Abandonment” mailed November 24, 2009.

*A. Appellant's arguments against the new grounds of rejection*

We note that the Request does not take issue with our above-noted interpretation of claim 11 (Decision 12) or our finding that claim 11 thus interpreted reads on Ito alone (*id.*).

Appellant takes issue with our finding that “Ito explains that *each* of musical instruments 10, 20, and 30 and mixer apparatus 40 can be implemented with apparatus like that depicted in Figure 3 ([Ito] ¶ 0041) . . . .” (Decision 13.) Paragraph 0041 reads as follows:

Next, one embodiment of the electronic musical instruments used as the aforesaid music apparatus 10, 20 and a mixer apparatus of electronic musical instrument function incorporating type used as mixer apparatus 40 will be described with reference to FIG. 3.

Appellant argues that this paragraph

does not mean that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40, when taken individually, *must necessarily* include all of the components shown in FIG. 3 (including the mixing circuit 82). Indeed, upon reading paragraphs 0041-0052 of Ito, it is possible to conclude that the electronic musical instruments 10, 20 and 30 and mixer apparatus 40, *only when taken collectively*, include all of the components shown in FIG. 3 (but when taken individually include only some of the components shown in FIG. 3).

(Req. Reh’g 2.) This argument overlooks our reliance on paragraphs 0023, 0053, and 0078 (Decision 13-14), which are not addressed in the Request. Paragraph 0023 describes Figure 3 as “a block diagram illustrating an embodiment of a music apparatus (electronic musical instrument) and a mixer apparatus of FIGS. 1 and 2.” Paragraph 0053 explains that “Bluetooth

modules 11, 21, 31, 41 of apparatus 10 to 40 are set in advance so that music apparatus 10 to 30 may function as slaves and mixer apparatus 40 may function as a master.” Note that operation as a master is described in Ito as employing a mixer. *See* Ito ¶ 0075 (“[T]raffic (transfer of information) can be controlled efficiently by allowing mixer apparatus 40 to function as a master and allowing the plurality of music apparatus 10 to 30 to function as slaves.”). Paragraph 0078 explains that “even if the combination of mixer apparatus 40 with plural music apparatus 10 to 30 *is changed*, one can meet the change speedily” (emphasis added). We remain of the view that these and the other paragraphs relied on in Ito would have been understood to mean that *each* of apparatuses 10, 20, 30, and 40 includes all of the circuitry depicted in Figure 3 (including mixing circuit 82) and is therefore capable of being used as the master. Ito therefore anticipates claims 11 and 27.

Alternatively, we conclude that it would have been obvious to implement each of Ito’s apparatuses 10, 20, 30, and 40 as a device having all of the circuitry depicted in Figure 3 in order to avoid the need to produce different types of master and slave devices.

*B. Appellant’s arguments regarding the Examiner’s rationale*

We are also affirming the rejection of claims 11 and 27 (and also of the dependent claims) for the reasons given by the Examiner. In addressing claims 11 and 27 in the Final Action, the Examiner found that “Ito only teaches that one apparatus on the network has a mixer, as differentiated from the claimed invention,” and concluded that “it would have been obvious to

one of ordinary skill in the art to adapt the Ito/Sitrick combination so that each device would have a mixing mechanism, as it has been held that the mere duplication of working parts does not constitute nonobviousness (see M.P.E.P. 2144.04).” Final Action 3. As correctly pointed out in the Brief (at page 3), our reviewing court has held that “reliance on per se rules of obviousness is legally incorrect and must cease.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). The Examiner responded to this argument by modifying the rationale of the rejection to additionally rely on Sitrick for a teaching of

a music compositions communication system which comprises workstations 105 which can be configured as either a master of a network or as a slave in a network of workstations (Col. 9, lines 44-48; Col. 14, lines 48-63; Col. 16 lines 60-66; Col. 17 lines 3-12), as is known in the art to be desirable so as to allow for different musicians to be able to shift control of the overall performance based on the circumstance or particular song being played.

(Answer 4.) According to the Examiner, “[t]his [disclosure in Sitrick] suggests to one of ordinary skill in the art that each musical apparatus have its own mixing mechanism, as Ito teaches that the ‘master’ apparatus has a mixing mechanism” (*id.* at 5-6.) We understand the Examiner’s position to be that it would have been obvious in view of Sitrick to include sufficient circuitry (including a mixer) in each of Ito’s apparatuses 10, 20, and 30 as well as in apparatus 40 so that any one of these four apparatuses can serve as

the master apparatus.<sup>3</sup> Appellant responds by taking issue with the Examiner's statement, also made in support of the rejection, that

it was not only known by one of ordinary skill in the art that in a group of such devices or *musical instruments* that the ability to switch from a "master" to a "slave" was desirable, but Sitrick demonstrates that it was both a known problem and a solution was taught in the prior art.

(*Id.* (emphasis added).) According to Appellant,

[t]his is an incorrect interpretation of Sitrick. . . . Sitrick does not disclose any synthesis devices (e.g., instruments) integrated into the networked devices. That is, Sitrick contemplates instruments that are separate from the networked devices. Sitrick discloses networked workstations that can act as master or master/slave (column 16, lines 65-66), but these workstations only display musical compositions and record and play performances—they do not include synthesis mechanisms. Thus the "problem" and solution which the Examiner alleges were known in the art w[ere] not actually taught by the prior art. Instead, they were gleaned from Applicant's disclosure.

(Reply Br. 3.) This argument is unpersuasive because the Examiner relies on Ito rather than Sitrick for plural apparatuses each having the recited "audio score synthesis mechanism." Specifically, the Examiner finds that each of Ito's apparatuses 10, 20, and 30 contains an audio score synthesis mechanism (Answer 3). The Examiner looks to Sitrick only for a teaching of providing each of Ito's apparatuses 10, 20, and 30 with sufficient circuitry (including a mixer) so that any one of them can serve as the master apparatus

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<sup>3</sup> This rationale does not depend on the per se rule of "mere duplication of working parts," mentioned at page 4 of the Answer.

as an alternative to apparatus 40, thereby permitting control to be shifted among the different musicians.

In response to Appellant's argument that "[i]ncluding a mixing mechanism in *each* of the musical apparatus . . . makes possible a real-time peer-to-peer musical jam session, a real-time peer-to-peer 'swarm,' or an ad-hoc musical jam session (specification, page 6, lines 19-20 and page 7, lines 10-12)" (Br. 4), we adhere to our previous finding that "Appellant has not demonstrated that the argued claim language requires such a capability." Decision 15. This finding is not addressed in the Request.

For the foregoing reasons, we are affirming the Examiner's rejection of independent claims 11 and 27 as well as the rejection of dependent claims 12-15 and 28-30, which are not separately argued. *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

#### SUMMARY

The Examiner's rejection of claims 11-15 and 27-30 under 35 U.S.C. § 103(a) for obviousness over Ito in view of Sitrick is affirmed.

We have also entered a new ground of rejection of claims 11 and 27 under § 102(e) and § 103(a) for anticipation by or obviousness over Ito.



APPELLANT'S OPTIONS FOR RESPONDING TO  
THE DECISION AND NEW GROUND OF REJECTION

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) (2010) provides that "Appellant may file a single request for rehearing within *two months* of the date of the original decision of the Board" (emphasis added).

Regarding the new ground of rejection of claims 11 and 27 entered pursuant to 37 C.F.R. § 41.50(b), that paragraph explains that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Appellant, within *two months* from the date of this decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .  
37 C.F.R. § 41.50(b) (2010). *See also* MPEP § 1214.01 (8th ed., rev. 7, July 2008).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(v) (2010).

AFFIRMED; 37 C.F.R. § 41.50(b)

Appeal 2009-003616  
Application 10/684,167

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